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BASF CATALYSTS LLC 100 CAMPUS DRIVE FLORHAM PARK, NJ 07932			CONLEY, SEAN EVERETT	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY B. HOKE, JOHN R. NOVAK,
JOHN J. STEGER, TERENCE C. POLES,
L. MICHAEL QUICK, RONALD M. HECK,
ZHICHENG HU, and MICHAEL DURILLA

Appeal 2008-3541
Application 09/766,723
Technology Center 1700

Decided: September 25, 2008

Before EDWARD C. KIMLIN, TERRY J. OWENS, and
CATHERINE Q. TIMM, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

The Appellants, in the “Cover Letter Enclosing Reply Brief” filed September 7, 2007, state that “[t]he Reply Brief also points out that claim 60 is indeed on appeal, and an argument is submitted for claim 60.”

In the “Reply (Substitute Brief)” referred to in that cover letter, the Appellants state that “[c]laims 49-60 stand finally rejected under

35 U.S.C. § 103(a) and are appealed” (Br. 3). In that same document, however, the Appellants state that the issues on appeal are:

- I. Whether claims 49-59 are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 5,711,071 (Fromson) in view of Abstract of DE 4007964 (Hager).
- II. Whether, claims 49-59 are unpatentable under 35 U.S.C. § 103(a) over EP 634205 (Beitz).

Claim 60 is not mentioned. That document’s “Conclusions” section states:

In view of the foregoing, claims 49-59 are not obvious over U.S. Patent No. 5,711,071 (Fromson) in view of Abstract of DE 4007964 (Hager).

In view of the foregoing, claims 49-59 are not obvious over Beitz.

Again, claim 60 is not mentioned. Moreover, contrary to the above-discussed cover letter, no argument is submitted for claim 60.

The Examiner, in the Examiner’s Answer mailed July 16, 2007, states (Ans. 2-3):

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant’s brief. The obviousness double patenting rejection over the claims of U.S. patent No. 5,620,672, and the rejections of claim 60 as being obvious over Fromson U.S. patent No. 5,711,071 and Hager DE 4007964 (abs) further in view of Appellant’s admission of the state of the art, and also as obvious over Beitz EP 634205 further in view of Appellant’s admission of the state of the art.

That statement is improper for two reasons. First, failure of the Appellants to challenge a rejection in their Brief does not remove the rejection from review on appeal. If the Examiner has not withdrawn the

rejection, the Examiner is to maintain the rejection in the Examiner's Answer. If that rejection is not challenged by the Appellants, the Board may summarily affirm it. Second, contrary to the Examiner's statement, the Final Rejection does not include a rejection of claim 60 over Beitz in view of the Appellants' admission of the state of the art.

In rejecting the Appellants' claims the Examiner relied only upon the Hager and Beitz abstracts (Ans. 3-4). We remand the application for the Examiner to reopen prosecution and reject the claims over the full Hager and Beitz references, English translations of which are in the electronic file. The Examiner and the Appellants also are to do the following:

1. If the Examiner intends to reject claim 60 over Beitz in view of the Appellants' admission of the state of the art, the Examiner is to enter a new ground of rejection of claim 60 over that art.
2. If the Appellants appeal the Examiner's rejections and those rejections include a rejection of claim 60, the Appellants are to clarify in their Brief whether claim 60 is on appeal. If claim 60 is not on appeal, the Appellants are to cancel that claim per the precedential Board decision *Ex parte Ghuman* (Bd. Pat. App. & Int. 2008), available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/rm081175.pdf>. If claim 60 is on appeal, the Appellants are to respond in their Brief to all rejections of that claim.
3. The Examiner is to include in the Examiner's Answer all rejections of all rejected claims.

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Application 09/766,723

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REMANDED

tf/lis

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